



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THOMAS, KAYDEN,
HORSTEMEYER & RISLEY LLP
600 GALLERIA PARKWAY, 15TH FLOOR
ATLANTA GA 30339

COPY MAILED

AUG 26 2008

In re Application of :
Tsao, et al. :
Application No. 09/827,106 : DECISION
Filed: 5 April, 2001 :
Attorney Docket No. 252016-3320 (67,200- :
344) :
:

This is a decision on the petition filed on 18 July, 2008, to revive the instant application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

NOTE: It appears that part of this file is in the image file wrapper (IFW) and part in the paper file. For future reference of Petitioner and the Office staff it is important that both files be consulted until such time that the entire file is generated/consolidated in IFW.

The petition is **GRANTED**.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

BACKGROUND

The record reflects as follows:

This application was held abandoned for Petitioner's (former Counsel's) failure to satisfy the Drawings Requirement of the Notice of Allowance/Allowability mailed on 28 January, 2003, with reply due under a non-extendable deadline on or before 28 April, 2003.

The application went abandoned after midnight 28 April, 2003.

The Office mailed the Notice of Abandonment on 13 June, 2003.

For Counsel appears to have made no inquiry of record thereafter until the filing of the original petition under 37 C.F.R. §1.181 to withdraw the holding of abandonment on 17 May, 2007. At that time, prior Counsel asserted that a reply was timely filed, and while neither the paper file nor Petitioner's original petition/submission support the averment, the Image File Wrapper indicates that drawings were submitted on 29 April, 2003, over a 24 April, 2003, certificate of mailing under 37 C.F.R. §1.8, however, because former Counsel not only failed to make the showing consistent with the guidance in the Commentary at MPEP §711.03(c), but also failed to do so timely under the rule (within two months of the act complained of), the petition was dismissed on 27 May, 2008.

The instant petition to revive under 37 C.F.R. §1.137(b) (with fee) was filed on 18 July, 2008, with a reply in the form of drawings and a statement of unintentional delay made by one other than the person under whose control the application went abandoned and Petitioner herein: (a) indicates that the statement of former Counsel is not available, and (b) did not have the inventor(s)/assignee(s) sign the statement of unintentional delay.

The record (including the petitions filed on 17 May, 2007, and 18 July 2008) does not necessitate a finding that the delay between midnight 28 April, 2003 (the date of abandonment), and 18 July, 2008 (the date of filing of grantable petition), was not unintentional.

Rather, as a matter of record, the U.S. Patent and Trademark Office notes that it is relying in this matter on the duty of candor and good faith of Petitioner Daniel R. McClure (Reg. No. 38,962) when accepting Petitioner's representation that the delay in filing the response was unintentional, and that the Office is construing Petitioner's signature on the petition to indicate that Petitioner has made the inquiry necessary to make such representation to the Office.¹

In the event that such an inquiry has not been made, Petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional, Petitioner must notify the Office.

¹ See: Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

As to Allegations of
Unintentional Delay

As indicated above, the requirements of a petition under 37 C.F.R. §1.137(b) are the petition and fee, the reply, the statement/showing of unintentional delay and, where appropriate, a terminal disclaimer and fee. It appears that the regulatory requirements have been satisfied herein.

CONCLUSION

Accordingly, The petition under 37 C.F.R. §1.137(b) is granted.

The instant application is released to Publications Branch to be processed into a patent in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Publications Branch in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the Publications Branch where that change of status must be effected—that does not occur in the Office of Petitions.

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2³) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.